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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HUYNH, KIM T

ART UNIT	PAPER NUMBER
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2112

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/531,240

Applicant(s)

PHILLIPS ET AL.

Examiner

Kim T. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15-23 and 29-40 is/are rejected.
- 7) ☒ Claim(s) 10-14 and 24-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 9, 15-17, 19, 23, 29, 34-35, 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Tognazzini (US Patent 5,860,023)

As per claims 1, 15, Tognazzini discloses a method of interfacing with a communication station, the method comprising:

- Receiving semi-structured data from a personal digital assistant (PDA) in a format native to the PDA; (col.8, lines 60-67 ie a remote device implies PDA)
- Parsing the semi-structured data to identify a type of the semi-structured data if the type of the semi-structured data is destination data, the data being distinct from the semi-structured data and provided by a source other than the PDA. (col.9, lines 1-42, ie central computing device parsed data to extract identification(distinct))

As per claim 2, Tognazzini discloses wherein the PDA wirelessly transmits the semi-structured data, in a standard PDA format, to the communication station. (col.7, lines 20-24, wherein data transmits via infra-red communication link implies wirelessly transmits)

As per claims 3, 17, Tognazzini discloses wherein the data is a part of an electronic document representing a physical document, and wherein the electronic document is captured without user intervention when the physical document is reproduced via a document reproduction system coupled to the communication station.(col.7, lines 20-24, col.8, line 60-col.9, line 42, ie the remote device (document reproduction system) submit typed questions (data of physical document) to central processing device, the processing device then parsed to extract the type and display for selections (this implies without using intervention from document reproduction system).

As per claims 5, 19, Tognazzini discloses wherein the semi-structured data specifies a manner with respect to how the data is sent, and wherein the data is sent to the destination according to the specified manner. (col.7, 18-41)

As per claim 23, Tognazzini discloses wherein the retrieving logic is further to connect to the source through a network using the source-location data extracted from the semi-structured data and download the information from the source. (col.7, 18-41), (col.8, line 60-col.9, line 15)

As per claim 9, Tognazzini discloses wherein fetching information comprises:

- connecting to a network; (ie audience members)
 - connecting to the source over the network using the source-location data extracted from the semi-structured data; (ie central computing device)
- (col.8, line 60-col.9, line 15)

- downloading the data from the source over the network to the communication station. (col.8, line 60-col.9, line 15)

As per claim 16, Tognazzini discloses wherein the communication interface receives the semi-structured data over an infrared beam in a standard PDA format. (col.6, lines 26-31)

As per claim 29, Tognazzini discloses a PDA interface for indicating to the PDA what actions were performed. (col.8, line 60-col.9, line 15)

As per claim 34 Tognazzini discloses a method of sending data from a communication station, the method comprising:

- Receiving semi-structured data from a personal digital assistant (PDA) in a format native to the PDA; (col.8, lines 60-67 ie a remote device implies PDA)
- Parsing the semi-structured data to identify a type of the semi-structured data; (col.9, lines 1-42, ie central computing device parsed data to extract identification(distinct))
- Acting on data in the manner indicated by the semi-structured data and a user, the data being distinct from the semi-structured data and provided by a source other than the PDA; and (col.9, lines 1-42, ie central computing device parsed data to extract identification(distinct))

- Returning a confirmation receipt to the PDA in a formative to the PDA, the confirmation receipt including a unique identification(ID) (col.10, lines 1-20)
- The communication interface for returning the job ID to the PDA. (col.10, lines 1-20)

As per claim 35, Tognazzini discloses wherein the uniqueID includes document/data sent, destination, and method of sending. (col.10, lines 1-32)

As per claim 37, Tognazzini discloses the system further comprising: a user identification logic for identifying an owner of the PDA from whom the data is received.(col.10, lines 1-32)

As per claim 38, Tognazzini discloses wherein the job ID further includes the identity of owner of the PDA. (col.10, lines 1-32)

As per claim 39, Tognazzini discloses a job history may be displayed to the user, when the user is identified. (col.10, lines 1-32)

As per claim 40, Fukuda discloses wherein a stored list of addresses used by the user in the past may be displayed to the user when the user is identified. (col.10, lines 1-32)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 6-8, 18, 20-22, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini (US Patent 5,860,023) in view Shah et al. (Pub No US20030105821)

As per claims 4, 7, 18, 21,, Tognazzini discloses all the limitations as above except the method further comprising prompting a user to select one of the plurality of destinations, if the destination data indicates a plurality of destinations, wherein the data is sent to the selected destination. However, Shah discloses for each designated recipient prompts the respective recipient for messaging information, receives the information from the recipient, and makes this information available to the sender via the server. The sender can select the desired messaging device by pointing and clicking with a mouse. [0060-0061]

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Shah's teaching into Shah's teaching into Tognazzini's system so as to provide for facilitating communication between a sending device and a receiving device. [0010]

As per claims 6, 20, 36, Shah discloses e-mailing the data if the destination is an e-mail address, and faxing the data if the destination is a fax number; and prompting a user to select the destination if the semi-structured data includes an email address and a fax number, and sending the data to the destination selected by the user. [0060-0061], wherein email address inherently mail server, fax number inherently fax-server)

As per claims 8, 22 Shah discloses the destination may one or more of the following: a copy feature of the communication device, an e-mail address, and a fax number. [0060-0061], wherein email address inherently mail server, fax number inherently fax-server, copy feature inherently print)

CLAIMS OBJECTION

5. Claims 10-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record as the prior art fails to teach or suggest fetching information from a search location indicated by the semi-structured data if the semi-structured data is a search request incompletely indicating the destination.

Claims 24-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record as the prior art fails to teach or suggest a retrieving logic to fetch information from a search location indicated by the semi-structured data if the semi-structured data is a search request partially indicating the destination.

Response to Amendment

6. Applicant's amendment filed on 4/26/05 have been fully considered but are moot in view of the new ground(s) of rejection.

a. In response to applicant's argument that there is no disclosure or suggestion within Tognazzini of specifying a destination via a semi-structured data native to the PDA. Examiner respectfully disagrees. As Tognazzini notes at col.8, line 60-col.9, line 42, discloses from figure 11, a process for the interaction between the central computing device(source) and a remote device(PDA). A remote device submit typed questions, the central processing device(source) received data and parsed to extract the user's identification and the question (implies specifying a destination). Thus, the prior art teaches the invention as claimed and the amended claims do not distinguish over the prior art as applied.

b. In response to applicant's argument that there is no disclosure of data is a part of an electronic document captured while a physical document is reproduced via a document reproduction system, without using intervention. Examiner respectfully disagrees. As Tognazzini notes at col.8, line 60-col.9, line 42, discloses the remote device (document reproduction system) submit typed questions (data of physical document) to central processing device, the processing device then parsed to extract the type and display for selections (this implies without using intervention from document reproduction system). Thus, the prior art teaches the invention as claimed and the amended claims do not distinguish over the prior art as applied.

c. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner relies on Shah's reference the teaching of prompting a user to select one of the plurality of destinations, if the destination data indicates a plurality of destinations, wherein the data is sent to the selected destination for combination. As Shah notes at paragraph [0060-0061], it is well established in the art to provide prompts which show the information available to sender/receiver for selections by select the desired messaging device by pointing and clicking with a mouse. In that at paragraph [0010] Shah's purpose is to provide facilitating communication between a sending device and receiving device via messages. It is clear that Shah is analogous art and therefore properly combinable for the purpose stated in the rejection of record.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Huynh whose telephone number is (571)272-3635 or via e-mail addressed to [kim.huynh3@uspto.gov]. The examiner can normally be reached on M-F 9:00AM- 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached at (571)272-3676 or via e-mail addressed to [rehana.perveen@uspto.gov].

The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.

Kim Huynh

June 30, 2005



REHANA PERVEEN
PRIMARY EXAMINER
7/7/05